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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,351	06/06/2005	Yoshiki Ishii	03500.018178.	3353
5514 7590 10/05/2010 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
JONES, HEATHER RAE				
ART UNIT		PAPER NUMBER		
2621				
MAIL DATE		DELIVERY MODE		
10/05/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,351

Applicant(s)

ISHII, YOSHIKI

Examiner

HEATHER R. JONES

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-9, 16, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-9, 16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed June 25, 2010 have been fully considered but they are not persuasive.

The Applicant argues that Murakami et al. fails to disclose generating first reference type data, which refers to the video data recorded on the recording medium, concurrently with video data capturing by the image pickup device, and recording the first reference type data as a file for reproducing the recorded video data, in combination with generating second reference type data, different from the first reference type data, the second reference type data referring to one or a plurality of the video data and/or one or a plurality of the first reference type data, in accordance with an instruction by the editing instruction unit or step and recording the generated second reference type data as a file for reproducing the video data subjected to editing. The Examiner respectfully disagrees. Murakami et al. discloses a video camera apparatus (Fig. 2A) for recording video data captured by an image pickup device (CCD – col. 5, lines 1-3) on a recording medium (40), said apparatus comprising: a first recording unit (camera with a CCD that captures the video signal) configured to (a) generate first reference type data (Figs. 3 and 4; col. 10, lines 12-30), which refers to the video data recorded on the recording medium (40), concurrently with video data capturing by the image pickup device (col. 4, line 64 – col. 5, line 5; col. 6, lines 26-47 - as the video signal is inputted from the CCD the recording medium (40) is recording

it) and (b) record the generated first reference type data on the recording medium as a file for reproducing the recorded video file (col. 6, lines 26-47 - files are being created, which are later able to be reproduced); and a second recording unit (the camera is integrated with a digital recording and reproducing apparatus) configured to (a) generate second reference type data (col. 9, lines 35-42), different from the first reference type data (the second reference type data is the playlist data and the first reference type data is the atom information), the second reference type data referring to one or a plurality of the video data and/or to one or a plurality of the first reference type data, in accordance with an instruction by the editing instruction unit and (b) record the generated second reference type data on the recording medium as a file for reproducing the video data subjected to editing instructed by the editing instruction unit (Fig. 3 – edit atom (134); col. 9, lines 35-42 - the play list data is equivalent to the index information being compiled to reproduce the moving picture; col. 17, lines 45-55). Murakami et al. does not explicitly show the editing unit, but the movie atom in Fig. 3 discloses an editing atom, thereby implying that editing has taken place. Therefore, Murakami et al. meets the claimed limitations and the rejection is maintained.

35 USC § 101

2. Regarding claim 18, this is considered statutory because the method is being performed by a video camera apparatus for recording video data captured by an image

pickup device. This is in the preamble, but the preamble is given weight because it is referenced in the first limitation where the first recording step of (a) generates a first reference type data which refers to the video data recorded on the recording medium, concurrently with video data captured by the image pickup device. Furthermore, this is considered to be a critical step of the method due to the fact that without the video data being captured there then no other limitations in the method could be performed. Also the image pickup device in this application is being referred to a CCD.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 6-9, 16, and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In regard to claims 1, 6-9, 16, and 19 it is noted that the specification discloses: " Note that the invention can be implemented by supplying a software program, which implements the functions of the foregoing embodiments, directly or indirectly to a system or apparatus, reading the supplied program code with a computer of the system or apparatus, and then executing the program code. In this case, so long as the system or apparatus has the functions of the program, the mode of implementation need not rely upon a program" (page 22, lines 18-23). As evidenced by the specification it appears that said claimed apparatus, comprising respective units, are capable of reading on software and as such do not fall into any statutory class of invention. Computer programs claimed as computer listings

per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 6-9, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Aridome et al. (WO 02/077865), but all citations will be cited from Murakami et al. (U.S. Patent 7,246,127) which is the U.S. printed publication of the Aridome et al. reference.

Regarding claim 1, Murakami et al. discloses a video camera apparatus (Fig. 2A) for recording video data captured by an image pickup device (CCD – col. 5, lines 1-3) on a recording medium (40), said apparatus comprising: a first recording unit (camera with a CCD that captures the video signal) configured to (a) generate first reference type data (Figs. 3 and 4; col. 10, lines 12-30), which refers to the video data recorded on the recording medium (40), concurrently with video data capturing by the image pickup device (col. 4, line 64 – col. 5, line 5; col. 6, lines 26-47 - as the video signal is inputted from the CCD the recording medium (40) is recording it) and (b) record the generated first reference type data

on the recording medium as a file for reproducing the recorded video file (col. 6, lines 26-47 - files are being created, which are later able to be reproduced); an editing instruction unit configured to instruct to edit the video data recorded on the recording medium (Fig. 3 - edit atom (134); col. 1, lines 37-40); and a second recording unit (the camera is integrated with a digital recording and reproducing apparatus) configured to (a) generate second reference type data (col. 9, lines 35-42), different from the first reference type data, the second reference type data referring to one or a plurality of the video data and/or to one or a plurality of the first reference type data, in accordance with an instruction by the editing instruction unit and (b) record the generated second reference type data on the recording medium as a file for reproducing the video data subjected to editing instructed by the editing instruction unit (Fig. 3 - edit atom (134); col. 9, lines 35-42 - the play list data is equivalent to the index information being compiled to reproduce the moving picture; col. 17, lines 45-55).

Regarding claim 6, Murakami et al. discloses all the limitations as previously discussed with respect to claim 1 including that an editing process instructed by the editing instructing unit is at least one of editing processes of division, combination, and partial deletion of the video data recorded on the recording medium (col. 9, lines 35-42 - the play list data is equivalent to the index information being compiled to reproduce the moving picture; col. 17, lines 45-55; col. 17, line 56 - col. 18, line 3 - deleting and re-arranging data).

Regarding claim **7**, Murakami et al. discloses all the limitations as previously discussed with respect to claim 1 including that the first reference type data includes (a) a first data structure which has a first time coordinate system and directly refers to the recorded video data recorded on the medium (Figs. 3 and 4; col. 6, lines 26-64 - QuickTime move file; col. 10, lines 12-30), and (b) a second data structure which has a second time coordinate system independent of the first time coordinate system and which indirectly refers to the video data recorded on the recording medium, by referring to the first data structure (col. 9, lines 35-42 - the play list data is equivalent to the index information being compiled to reproduce the moving picture; col. 17, lines 45-55).

Regarding claim **8**, Murakami et al. discloses all the limitations as previously discussed with respect to claims 1 and 7 including that the first reference type data is of QuickTime or an expansion format of QuickTime (Figs. 3 and 4; col. 6, lines 26-64 - QuickTime move file; col. 10, lines 12-30).

Regarding claim **9**, Murakami et al. discloses all the limitations as previously discussed with respect to claims 1 including that the second reference type data is a play list describing a reproducing mode of data content including the video data recorded on the recording medium (col. 9, lines 35-42 - the play list data is equivalent to the index information being compiled to reproduce the moving picture; col. 17, lines 45-55).

Regarding claim **16**, Murakami et al. discloses all the limitations as previously discussed with respect to claim 1 including that the apparatus further

comprises a reproducing unit configured to reproduce the video data recorded on the recording medium, wherein the reproducing unit is arranged to reproduce respective video data recorded on the recording medium, according to the first reference type data and the second reference type data (col. 7, line 40 – col. 8, line 67).

Regarding claim **18**, this is a method claim corresponding to the apparatus claim 1. Therefore, claim 18 is analyzed and rejected as previously discussed with respect to claim 1.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. as applied to claims 1 and 9 above.

Regarding claim **19**, Murakami et al. discloses all the limitations as previously discussed with respect to claim 9, but fails to disclose that the second reference type data is of SMIL or an expansion format of SMIL. Official Notice is taken that it is well known in the art to use synchronized multimedia integration language (SMIL) to time the play back of the moving picture file and audio file synchronously. Therefore, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to have used the SMIL format for the second reference type data to ensure the relationship between the moving picture file and the audio file can be clearly synchronized.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEATHER R. JONES whose telephone number is (571)272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Heather R Jones
Examiner
Art Unit 2621

HRJ
September 11, 2010

/Peter-Anthony Pappas/
Supervisory Patent Examiner, Art Unit 2621